



PATENT CASE IN01155K

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of:

S. Venkatraman *et al.*
Serial No.: 09/836,636
Filed: April 17, 2001

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Examiner: D. Lukton
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Group Art Unit: 1653

U.S. 6,914,122
Issue date: July 5, 2005

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:
For: "Macrocytic NS3-Serine Protease
Inhibitors of Hepatitis C Virus
Comprising Alkyl and Aryl
Alanine P2 Moieties"
:
:
-----X

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450
Mail Stop: Petition

**REQUEST FOR RECONSIDERATION OF APPLICATION FOR PATENT
TERM ADJUSTMENT**

Sir:

This is a request for reconsideration of the patent term adjustment of 373 days indicated in the "Determination of Patent Term Adjustment under 35 U.S.C. §154(b)" on the Issue Notification as well as on the above-noted issued patent in the present case. Applicants had requested on March 23, 2004 that Applicants be afforded a patent term adjustment of **406 days**. In its "Decision on Application for Patent Term Adjustment" that the Office mailed on April 6, 2005, Applicants were given two months time from the issue date of the patent to request reconsideration of the patent term adjustment indicated on the patent. Accordingly, this request is being filed and is considered timely filed. As stated in the Decision, a copy of that Decision is also attached. Applicants request reconsideration of the Patent Term Adjustment and be accorded the originally requested 406 days.

July 18, 2005
Schering-Plough Corporation
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Respectfully submitted,


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UNITED STATES PATENT AND TRADEMARK OFFICE



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PATENT DEPARTMENT
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APR 11 2005

SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1 1990)
2000 GALLOPING HILL RD
KENILWORTH NJ 07033-0530

Computer Review LMData Entry Date 04/13/2005PA LMAttny PSE☐ FILE ☐ CHECK FILE

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APR 06 2005

OFFICE OF PETITIONS

ACTION: Request for Reconsideration? (Yes)DATE DUE: 06/06/2005(follow up 2 months from patent issuance)

In re Application

Venkatraman, et al. ✓

Application No. 09/836,636 ✓✓

Filed: April 17, 2001 ✓✓

Atty Docket No. IN01155K ✓✓

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: DECISION ON APPLICATION

: FOR PATENT TERM ADJUSTMENT

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This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 C.F.R. § 1.705)(b)", filed March 23, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred thirty-two (132) days to four hundred six (406) days.

The application for patent term adjustment is GRANTED to the extent indicated herein. However, applicants' request that an additional PTO delay of one hundred fifty-seven (157) days be assessed is being HELD IN ABEYANCE until after the actual patent date.

Applicants are given two months from the issue date of the patent to request reconsideration of the patent term adjustment indicated on the patent application. Applicants may seek such reconsideration without payment of the fee. A copy of this decision should accompany applicant's written request for reconsideration.

On March 10, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is one hundred thirty-two (132) days. On March 23, 2004, applicants timely¹ submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is four hundred six (406) days.

Applicants specifically states that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of one hundred thirty-two (132) days based on an adjustment for PTO delay of one hundred sixty-six (166) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(2), reduced by applicants' delay of thirty-four (34) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b). Applicants' delay of 34 days has been reviewed and found to be correct. The adjustment of one hundred sixty-six (166) days is at issue.

A review of the application file reveals that the Office mailed a Restriction Requirement on February 19, 2002. Applicants timely filed an Election on March 26, 2002. However, the Office mailed a Notice of Non-Complaint Amendment on April 10, 2002. Applicants filed a proper reply on April 29, 2002, and pursuant to 37 C.F.R. § 1.704(c)(7), were properly assessed applicant delay of thirty-four (34) days.

Pursuant to 37 C.F.R. § 1.703(a)(2), the Office had four months, or until August 29, 2002, to mail either an action under 35 U.S.C. 132 or a Notice of Allowance. The Office mailed a "Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures" (hereinafter "Sequence Notice") on February 11, 2003, and was improperly assessed PTO delay of one hundred sixty-six (166) days. The Office has stated that a Sequence Notice is **not** an action under 35 U.S.C. 132.² The Office did not mail an action under 35 U.S.C. 132 until May 5, 2003. Accordingly, PTO delay should have been assessed as two hundred forty-nine (249) days, not one hundred sixty-six (166) days.

¹ PALM records indicate that applicants paid the issue fee on March 31, 2004.

² See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 1239 OG 14 (Oct. 3 2000).

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **two hundred fifteen (215) days** (249 days of PTO delay reduced by 34 days of applicant delay).

The \$200.00 fee set forth in 37 C.F.R. \$1.18(e) has been charged to Deposit Account No. 19-0365, as authorized.

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Karin Ferriter
KF

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen



JZW
DAC

Attorney Docket No.: IN01155K

PTO/SB/92 (09-04)
Approved for use through 07/31/2006. OMB 0561-0031
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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Application No.: 09/836,636

Filing Date: 04/17/2001

Applicant: S. Venkatraman et al.

Title: "Macrocyclic NS3-Serine Protease Inhibitors of Hepatitis C Virus Comprising..."

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on 07/18/2005
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Signature

PALAIYUR S. KALYANARAMAN

Typed or printed name of person signing Certificate

34,634

Registration Number, if applicable

(908) 298-5068

Telephone Number

Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

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Request for Reconsideration of Application for Patent Term Adjustment - 2pgs.

Copy of Decision - 3pgs ; Post Card

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